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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,947	10/31/2005	Brian Russell Logan	4623-051371	1706
28289 7590 09/14/2009 THE WEBB LAW FIRM, P.C. 700 KOPPERS BUILDING 436 SEVENTH AVENUE PITTSBURGH, PA 15219				
EXAMINER				
AHMAD, CHARISSA L				
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3635				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/534,947

**Applicant(s)**

LOGAN ET AL.

**Examiner**

Charissa Ahmad

**Art Unit**

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18, 20 and 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18, 20 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 May 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. The amendment filed on 3/19/09 is acknowledged. Claims 1-18, 20 and 21 will be considered below.

***Drawings***

2. The replacement drawings were received on 3/19/09. These drawings are not acceptable and will not be entered. Accordingly, since the amendment to the specification relates to the new drawings, it will also not be entered. The amount of detail shown in new Figures 10a-10c and 11 is not adequately supported by the original disclosure. Applicant is reminded that the method claims can easily be illustrated via a flow chart including the various steps in boxes rather than the proposed Figure 11. Because the drawings will not be entered, the previous drawing objection stands and will be repeated below.

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims.

a. Therefore, the spike twisted about an axis as described in claim 15 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

b. Therefore, the pressing station, including the pressing station having a female template, as described in claims 17-19 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet,

even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. **Claims 20 and 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.** The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 20 discloses “a panel formation” in line 5, which was not previously disclosed in the original disclosure. It does not appear that the original disclosure provides

support for this limitation and it is unclear to the Examiner what exactly is meant by this new limitation.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. **Claims 1-15, 20 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.** Claims 1 and 20 recite “a continuous metal web.”

Examiner fails to see how the web of Applicant’s connector is continuous when it is clearly not continuous in a direction along the flanges of an I-beam, but rather is broken up by holes that extend from one attachment section to the other attachment section.

***Claim Rejections - 35 USC § 102***

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. **Claims 1-4, 8-12, 14-16, 20 and 21 as best understood are rejected under 35**

**U.S.C. 102(b) as being anticipated by Sanford (U.S. Pat. 3,416,283). [Claims 1, 16 and 20]**

Sanford discloses a metal connector (113) capable of use in the fabrication of structural I-beams, the connector including: a continuous metal web (the web could extend continuously along a direction of flanges of an I-beam - see Figure 1 and the web would also be capable of extending transversely along the flanges since the web is formed with circular apertures that could connect to the teeth of the attachment section at any desired angle) and two spatially separated

attachment sections (126) that can be located between the timber members of each flange, wherein at least one of the attachment sections (126) has a plurality of spikes (128) projecting outwardly from opposite sides capable of fastening one pair of timbers to the connector to form the flanges of a beam (Figs. 13 and 15). As for the recitation of the attachment sections being "integrally formed with the metal web," it has been held that the term "integral" is sufficiently broad to embrace constructions united by such means as fastening and welding. *In re Hotte*, 177 USPQ 326, 328 (CPA 1973). In the instant case, the attachment sections are attached to the web via the apertures in the web and the teeth on the attachment sections. **[Claim 2]** Each attachment section (126) has spikes (128) projecting outwardly from each side for piercing and fastening pairs of timber members (Fig. 15). **[Claim 3]** The spikes (128) are provided by tabs made in the attachment section (126) and interconnected by bending interconnecting portions (Figs. 15 and 7). **[Claim 4]** The interconnection portion of spikes (128) projecting outwardly from one side of the attachment section (126) are adjacent the interconnecting portion of spikes (128) that project outwardly from the opposite side (Figs. 14 and 15). **[Claim 8]** The spikes (128) are arranged in rows and ranks, interpreted as described by applicant (i.e. diagonally), on the attachment section (126) such that adjacent interconnecting portions of the spikes from opposite sides of the attachment section (126) are in different ranks (Figs. 14 and 15). **[Claim 9]** The ranks are arranged diagonally such that the interconnecting portions of the spikes (128) in one rank are adjacent interconnecting portions of spikes (128) in another rank (Fig. 14). **[Claim 10]** The rows and ranks are defined by a plurality of pairs of spikes (128) projecting outwardly from the attachment section (126) (Figs. 14 and 15). **[Claim 11]** The rows and ranks are defined by pairs of spikes (128) projecting from one side of the attachment section (126) and adjacent

ranks have pairs of spikes (128) projecting outwardly from opposite sides of the attachment section (126) (Figs. 14 and 15). [Claim 12] The length of the spike (128) is 10mm, described as 3/8" (Col. 4 Lines 30-31). [Claims 14 and 15] The spike (128) is twisted about an axis lateral to the attachment section (126) to prevent the timber from separating from the spike (128) (Col. 4 Lines 58-69). [Claim 21] The continuous metal web includes stiffening elements (23 and 24) formed thereon (Fig. 4).

*Claim Rejections - 35 USC § 103*

10. **Claims 5, 6, 7, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanford (U.S. Pat. 3,416,283).** Sanford discloses all the limitations of the invention as described above, but lacks a specific disclosure of claimed dimensions. However, the claimed dimensions, absent a disclosed criticality, are viewed as a choice of design which would have been obvious, at the time of the invention, to one having ordinary skill in the art as it involves nothing other than routine experimentation to determine optimal dimensions and there is no unpredictable or unexpected result achieved. Further, it is well known in the art to use a properly dimensioned apparatus in order to avoid unwanted failure of said apparatus.

11. **Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanford (U.S. Pat. 3,416,283) in view of Jureit (U.S. Pat. 4,157,676).** Sanford discloses the connector as described above, but lacks details on the method of manufacture. Jureit teaches it is known to use a press for constructing structural members, specifically structural members including sandwiched plate connectors (Jureit Fig. 6). Therefore, it would have been obvious to

one of ordinary skill in the art, at the time of the invention, to assemble the structural support member of Sanford using a press, as taught by Jureit, as a known means of assembling members using plate connectors without any new or unexpected results. The use of a press, as modified by Jureit, would necessarily entail the steps of positioning the connector between the timbers in the press and applying force for both connection sections.

### ***Response to Arguments***

12. Applicant's arguments with respect to claims 1 and 20 have been considered but are moot in view of the new ground(s) of rejection.

13. Applicant's arguments filed 3/19/09 with respect to claims 17 and 18 have been fully considered but they are not persuasive. Applicant argues that Jureit does not disclose the connector of the claimed invention. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Jureit is used in combination with Sanford to teach that it is well known in the art to use a press for constructing structural members, specifically structural members including sandwiched plate connectors.

### ***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.



15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charissa Ahmad whose telephone number is (571) 270-5220. The examiner can normally be reached on Monday - Friday 7:30 am to 5 pm (alternate Fridays off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (571) 272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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